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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,742	11/28/2000	John S. Hendricks	026880.00021	6312
4372 7590 05/29/2007 ARENT FOX PLLC 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER GEREZGIHER, YEMANE M	
			ART UNIT 2144	PAPER NUMBER
			MAIL DATE 05/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/722,742

Applicant(s)

HENDRICKS, JOHN S.

Examiner

Yemane M. Gerezgiher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-20 and 22-35 is/are pending in the application.
- 4a) Of the above claim(s) 34 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-20 and 22-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The response received on 03/02/2007 has been entered and made of record. Claims 1-9, 12-20 and 22-35 are now pending in this application:

Claim Objections

2. Claim 12 is objected to because of the following informalities: The claim depends on a cancelled claim. Furthermore, claim 12 recite "...the catalog printer..." which lack a proper antecedent basis. No "catalog printer" was previously defined in the claim.

Appropriate correction is required.

Election/Restrictions

3. Newly submitted claims 34-35 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Applicant claim among other limitations, "a remote operations center that distributes electronic books to be stored at the file server; ... a controller only able to download books to a specific type of electronic viewer ... the electronic viewer including a secure microprocessor configured to decode encoded electronic book data only at the time of display, the viewer being configured to decode the encoded electronic book data page-by-page" as recited in the newly added claim 34. These functional limitations partially directed to resource allocation by means of distributing or uploading e-book contents to be stored at a file server (communication of content between the remote operation center and the file server), downloading of the e-book contents to a specific type of a electronic viewer via the controller and

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the viewer including a secure microprocessor decoding encoded electronic book data specifically at the time of display, which was not originally claimed invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 34-35 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-9, 12-20, 22-29 and 31-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 16 and 24 now recite the following functional limitation:

“wherein the viewer is limited to receiving a determined number of electronic books at a time from the controller”

The inventive entity points to a statement that read "it is preferred that the public viewer be limited to receiving one or two books at a time from the controller" Specification Page 24 lines 14-17.

However, such a plain statement could not be enabling support of the claimed limitation. The statement as recited in the specification (also disclosed above) remains to be no more than a consideration or contemplation of desire, without any specific functional steps showing one or ordinary skill in the art how to make use of the claimed limitation. Barely statement of "preference" is not equivalent to enabling support showing specific steps of the claimed limitation. The cited support of the specification would not have enabled one of ordinary skill in the art to make use of the claimed invention at the time of the invention.

Note: The patent law requires that applicant must disclose his invention in such detail that it will not require undue experimentation for one skill in the art. Applicant did not comply this requirement of the first paragraph. The examiner contends (at the time the invention was made) that it would require undue experimentation for one of ordinary skill in the art of electronic documents to make and use the claimed invention for the reasons set forth in the claims. Applicant is reminded that no new matter is allowed in the amendment to the specifications under 35 U.S.C. 132 and 37 CFR 1.118(a).

Thus, claims 1-9, 11-20, 22-29 and 31-33 are rejected, because the functional limitation disclosed above are not enabled by the original and/or the present specification of the application.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

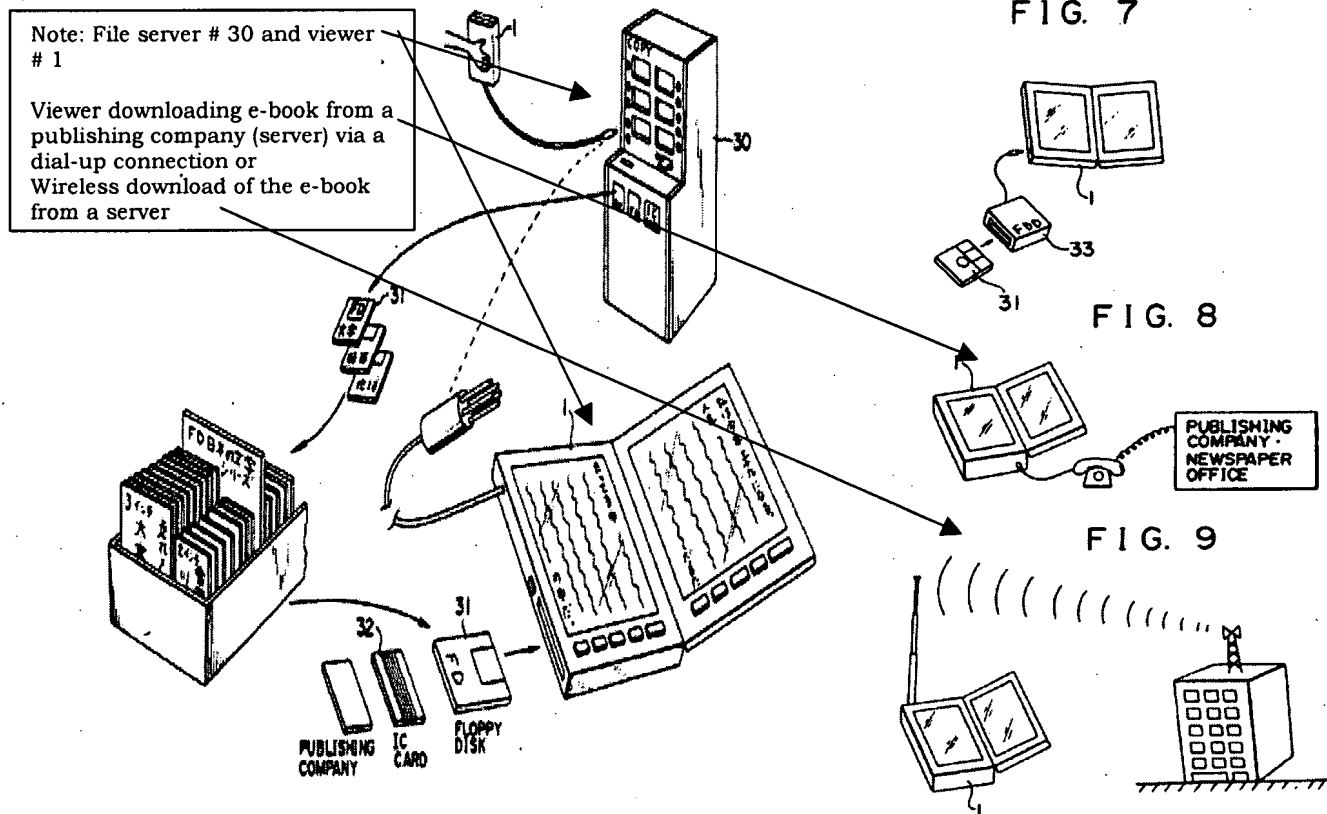
7. Claims 1-9, 12-14, 16-20, 24, 25 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warnock et al. (U.S. Patent Number 5,634,064) hereinafter referred to as Warnock in view of Tsuchiya (U.S. Patent Number 5,239,665)

As per claims 1, 16 and 24, Warnock Disclosed formation, delivery and presentation of electronic documents (journals articles and the like) and more particularly to the viewing of electronic documents at the user interface of the viewer viewing the selected documents (electronic documents selected from the provider and downloaded to a memory of the viewer/client) having therein a selector facilitating selection of desired electronic documents between the server providing the selected document and the viewer requesting the service. See ABSTRACT, Figure 3a, Column 1, Lines 10-20, Column 3, Lines 3-30 and Column 2, Lines 37-59. Warnock disclosed a reader/viewer digital computer system having therein a memory for storing the selected electronic documents (claim 3). See ABSTRACT and Column 14, Lines 49-65. Warnock further disclosed a system directed to digital processing system, the selector/controller having "software for controlling" (stored control programs and scripts) (claim 4) See Column 6, Lines 11-33. Warnock taught a controller having therein a viewing screen controlling the displayed electronic document (claims 6, 7 and 8). See Figures 1, 2 and 3a. Warnock also disclosed a printer connected to the digital

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computer/server printing electronic documents created and stored therein and printing the selected electronic documents based on displayed titles of the documents displayed for viewing by a client and printing the electronic documents by the printed connected to the system (claim 25). See Column 4, Lines 35-44, Column 5, Lines 47-62, Column 8, Lines 8-20, Column 10, Line 36 through Column 10, Line 17). Warnock substantially disclosed the invention as claimed. Warnock disclosed a digital machine having therein a selector, a storage or server containing the electronic content and a user interface allowing the viewer to navigate through the desired electronic document. However, Warnock was silent about the selection of electronic documents in a network (at least two devices connected in some fashion and was silent about renewing or replacing or downloading additional electronic book/document from the file server.

However, as evidenced by Tsuchiya, transmitting electronic documents from server to a client via a third party or a controller or manager was known in the art at the time the invention was made. Tsuchiya disclosed a method of transmitting electronic books from a server ("file server") containing electronic books to an electronic book ("viewer") having therein user interface for displaying the content pages of the selected electronic book and downloading/storing the content on the electronic book on the memory of the client device ("viewer"). Tsuchiya disclosed a viewer accessing a single server which could store limited content of the electronic document/book (claim 9) recited, "Electronic books which are designed to obtain information via a telephone network...Pieces of information may be transferred directly and stored in the inner memory of the electronic book (claims 2, 17, 18, 27 and 28) via telephones and appropriate modems. Later, a reader can have access to a desired piece of information for display." See Figures 6-8 (also disclosed below), Column 6, Lines 7-16 and Column 6, Lines 45-54.



Furthermore, Tsuchiya disclosed a user the viewer bringing the viewer back to the source (file server OR e-library) for additional e-book by means of replacing an external memory mountable to the viewer or remotely connecting the viewer to the source via a telephone network or IR signal to store additional e-book on the server. See Tsuchiya, Abstract, Figs. 6, 8-9, Column 5, Lines 25-67, Column 6, Lines 19-54.

Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Tsuchiya related to transmitting electronic books on the Internet and the deleting stored documents at the client system in a specified period of time and converting video signal to an electronic signal and have modified the

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teachings of Warnock related to selecting and viewing electronic documents on a digital computer having therein a viewing display, because such a modification would protect proprietary rights of publishers and authors and allow a reader to have access to electronic documents/books that are remotely located on a server and would facilitate the distribution of electronic books widely (See Warnock, ABSTRACT and Figures 7-9).

Claim 13 has limitations substantially similar as in claim 1 rejected above. Thus, it is rejected with the same rationale. Further, Warnock disclosed a catalog printer connected to the file server that is capable of printing information about electronic books stored on the file server (See Column 4, Lines 35-44, Column 5, Lines 47-62, Column 8, Lines 8-20, Column 10, Line 36 through Column 10, Line 17, a printer connected to the digital computer/server printing electronic documents created and stored therein and printing the selected electronic documents based on displayed titles of the documents displayed for viewing by a client and printing the electronic documents by the printer connected to the system). Having that said, the teachings of Warnock disclosed a printer and displaying of listings that are downloadable to the viewer on the viewer interface; printing the selected electronic documents based on displayed titles of the documents displayed for viewing by a viewer UI. Having that said, it is a common sense that the printer is capable of printing a desired type of content be it a "information stored in the file server" or other information. Thus, claimed limitation is within the scope of the cited section of the teachings of Warnock. Further disclosed Characters in this string been encoded using a predefined encoding mechanism (see Warnock Column 12, Lines 62-64).

8. Claims 15, 22, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warnock et al. (U.S. Patent Number 5,634,064) in view of Tsuchiya (U.S. Patent Number 5,239,665) further in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

With respect to the rejection applied above, the combined teachings of Warnock and Tsuchiya substantially disclosed the invention as claimed. However, failed to teach deleting stored files after a specific periods of time from the viewer's memory and limiting access to file servers and converting video signal to electronic book/document as claimed in this invention.

Examiner takes Official Notice (see MPEP § 2144.03) that "deleting stored files after a specific periods of time from the client's memory (claims 22 and 26) limiting access to file servers and controlling the number of electronic documents that could be downloaded by a client, converting a video signal to electronic document which could be displayed at a client's display (claims 15 and 23)" in a computer networking environment was well known in the art at the time the invention was made. For example, a Japanese Patent No. JP405334167A entitled "NETWORK FILE SYSTEM MANAGING DEVICE" disclosed deleting information stored (downloaded on the client system) at a determined period of time in accordance with information received ("A file deleting part 51 deletes a file included in the client computer in accordance with information stored in a deleting file information storing part 50"). See ABSTRACT. Furthermore, A patent issued in 1977 (Ryan et al. 4,023,408) disclosed, "means to delete data stored in locations identified by said write counter means if said elapsed time exceeds a predetermined period" Column 33, 46-49, Sugiura (U.S. Patent Number 5,146,600) issued in 1992 disclosed, "While the deletion of a document is effected with the control data for the document deleted from the hard disk, any appropriate means may be provided to determine whether a document should be deleted or to **automatically delete a document on**

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confirmation that the document has been saved for a predetermined period of time". Column 20, Lines 11-16 and Takahashi (U.S. Patent Number 5,565,999) disclosed "controlling means erases the program information stored in the memory means after elapse of a predetermined time period" (Column 8, Lines 39-41). Another example is Jackson et al (U.S. Patent Number 5621658), Column 10, Lines 5-7, Column 7, Lines 19-22, which disclosed pattern recognition, and converting a media to electronic text. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight. 9

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings which were well known in the art at the time the invention was made and have modified the already combined teachings of Tsuchiya related to transmitting electronic books on the Internet and Warnock related to selecting and viewing electronic documents on a digital computer in order to protect proprietary rights of publishers and authors by temporarily allowing clients to store and view electronic contents of interest.

As per claim 32, Tsuchiya disclosed receiving one or two electronic books from the file server # 30 (see Fig. 6, also disclosed above, Column 1, Line 44 through Column 3, Line 67, selected e-book viewer based on the type of storage, storing limited number of electronic documents).

As per claims 31 and 33: The already combined teachings of Tsuchiya and Warnock substantially disclosed the invention as claimed. However, the combined teachings failed to teach a limitation directed to an authorization process to allow access only to authorized viewer. Nevertheless, controlling access to computer resources only to authorized client/viewer via an authorization means was well known in the art at the time the invention was made (See Weiss, Column 10, Lines 5-24). Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Weiss related to authorization process and have modified the already combined teachings of Tsuchiya and Warnock in order to assure secure access to the information resource (Weiss Column 1, 6-8, 56-57).

Response to Arguments

9. Applicant's arguments filed 03/02/2007 have been fully considered but they are not persuasive.

Applicant once again presents substantially the same arguments previously addressed (see, Applicant's Remark on Page 11, ¶3) in the last few office actions. The inventive entity, now argues that the previously amended limitation of claims 1, 16 and 24 ("wherein the viewer is limited to receiving a determined number of electronic books at a time from the controller" as been supported by the original specification. The inventive entity points to a statement that read "it is preferred that

the public viewer be limited to receiving one or two books at a time from the controller...”
Specification Page 24 lines 14-17 and the originally filed claims 21 and 29 of this instant application.

→ However, the examiner respectfully disagrees that such a simple statement could be enabling support of the claimed limitation. The statement as recited in the specification (also disclosed above) remains to be no more than a consideration or contemplation of desire, without any specific functional steps showing one of ordinary skill in the art how to make use of the claimed limitation. Barely statement of “preference” is not equivalent to enabling support showing specific steps of the claimed limitation. The cited support of the specification would not have enabled one of ordinary skill in the art to make use of the claimed invention at the time of the invention. The originally filed claims 21 and 29 of this instant application filed on 11/28/2000 does not cure the problem as this instant application benefits a priority claim of a divisional application SN: 08/336,247 filed on 11/07/1994 which is a CIP of 07/991,074 filed on 12/09/1992.

After reconsidering applicant’s amendment/remark the examiner note that there is **no functional limitation that prevents the viewer from downloading e-books based on a defined number of books further including no design of realizing, knowing or identifying how many e-books the viewer actually might have already downloaded.** Thus, the examiner maintains his position that there is no written enabling support in the specification that fully supports the alleged functional limitations as recited in the amended claims.

Applicant argues “Tsuchiya does not disclose or suggest the system including a viewer limited to receiving a determined number of electronic books at a time from a controller (applicant’s remark on Page 10, ¶1).

→ Examiner respectfully disagrees with such allegation. As recited in the body of the rejection, Tsuchiya, taught transmitting electronic documents from server to a client via a third party

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or a controller or manager. Tsuchiya further disclosed a method of transmitting electronic books from a server ("file server") containing electronic books to an electronic book ("viewer") having therein user interface for displaying the content pages of the selected electronic book and downloading/storing the content on the electronic book on the memory of the client device ("viewer"). See Figures 6-8 (also disclosed above), Column 6, Lines 7-16 and Column 6, Lines 45-54. Examiner also note at the time the invention of Tsuchiya was made, the "viewer" (electronic book device) essentially (at least at the time of the invention) had a limited capability and capacity of storage, which necessarily imply that the viewer downloads or receives a limited number or size of electronic book or content from the recited file server at the time.

Applicant further contends, "In the office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 9. This is an insufficient showing of motivation" (Remark Page 11, ¶12).

→ Examiner notes that the obviousness rejection did not end on page 9 of the last office action as alleged by the applicant. However, the obviousness analysis of the rejection continues on pages 10 through 11, which show a proper and sufficient rejection as recited in the last action. For applicant's convenience, examiner point to pages 10-11, where the obviousness rejection is properly addressed.

Note: As the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

It is the examiner's position that the incremental amendment made to the claims so far has been minimal to properly overcome the prior art of record by providing a patentably unique functional limitation to overcome the pending rejection and if further prosecution on the merits of the instant application is pursued, Applicant is strongly encouraged to further incorporate into the independent claim some details or features (if any) of this instant application in order to at least overcome the pending rejection and perhaps expedite prosecution of this instant application.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

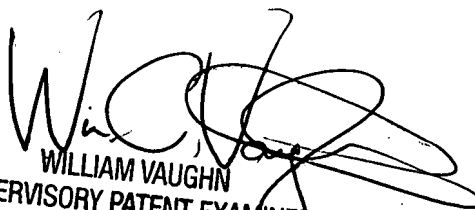
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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yemane M. Gerezgiher whose telephone number is (571) 272-3927. The examiner can normally be reached on 9:00 AM - 6:00 PM Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Y. Gerezgiher
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